

## Remarks

Claims 1-67 are pending in the application. By the foregoing amendment, Applicants have amended claims 1, 2, 6, 7, 15, 39, 40, 41, 60, 61, 65 and 66 to correct typographical/editorial errors in Claims 1, 39 and 60 and to insert a lower limit for the diameter of the inscribed circles in all amended claims. No new matter is entered as the lower limit of 0.001" diameter is fully supported in subsection (a) of paragraph 52 spanning pages 18 and 19 of the specification.

Indefiniteness

In paragraph 2 of the Office Action, the Patent Office has reiterated its rejection of claims 60-66 under 35 USC 112, second paragraph, as being indefinite, alleging that these claims are *de facto duplicates* of claims 1-7. Additionally, the Patent Office has introduced a new rejection under this same section alleging that claims 1 and 60 include phrases, e.g., (a) and (c), that are without apparent significance. Applicants respectfully traverse the rejections and request reconsideration.

First, Applicants reiterate their contention that they are not convinced that Claims 1-7 are in fact *de facto* duplicates of claims 60-67. As noted in Applicants' prior response, the cross-section of the adhesive bead could be triangular in shape. It is equally contemplated that the cross-section could be of a shape corresponding to the lower half of a triangle as shown in Figure 1 below:

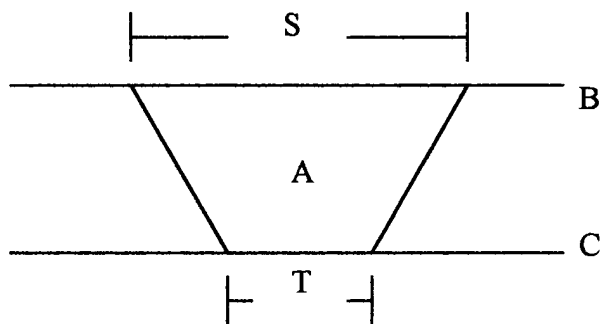


Figure 1

wherein A is the bead of adhesive, B is the test surface on the outward side of the adhesive A wherein the diameter of an inscribed circle at the point of cross-section is S, and C is the test surface against the inward side of the adhesive wherein the diameter of an inscribed circle at the point of cross-section is T. With this shape of adhesive bead, assuming that the shape of the bead does not change across the surface area of the susceptor sheet, if T is 1/2" and S is 3/4", this device would be covered by the literal text of Claim 60 but not by the literal text of Claim 1. Similarly, if this same bead were present and B were the test surface on the inward side of the adhesive and C where the test piece on the outward side of the adhesive, this device would be covered by the literal text of Claim 1 but not by the literal text of Claim 60. Thus, this is not a situation, as described in MPEP 706.03(k), where two claims "are duplicates, or else so close in content that they both cover the same thing, despite a slight difference in wording." As also stated in this section of the MPEP, a mere difference in scope between claims has been held

enough to warrant the claiming of an invention by plural claiming. As noted from this example, from a literal perspective, Applicants are claiming similar inventions, but ones of slightly different scope. Thus, both sets of claims are proper and should be maintained. In view of this, Applicants request that the rejection be withdrawn.

In relation to the seemingly extraneous phrases, Applicants advise that these are mere markers or identifications of various elements of the claims. Applicants might just as well have used numbers (1, 2, 3, 4, etc.), roman numerals (i, ii, iii, iv, etc.) or capital letters (A, B, C, D, etc.) all to the same effect: identifying key elements of the claims. Rather than initiate a new sequence with each claim, Applicants have chosen to maintain the sequence in correlation with the sequence of elements as disclosed in the specification itself for ease of reference. Thus, Applicants believe their use of such index is clear and appropriate and, therefore requests that the rejection be withdrawn.

#### Anticipation/Obviousness

In Paragraph 3 of the Office Action, the Patent Office has maintained its rejection of Claims 1-67 under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103 as being obvious over Brooks, Perrin et. al. or Jackson, Jr. et. al. The Patent Office states that Applicants' remarks in the prior response are "simply not agreed with" but provides no clarity or specificity as to what the points of disagreement are. The Patent Office goes on to indicate that Applicants' arguments "concerning the performance parameter of claim 1 are clearly in error. That is, the phrase "can have" etc. does not mean that it must have the particular property recited." Finally, the Patent Office also states that Applicants' use of the phrase "or less" in relation to the diameter allows for circles having "no diameter at all". Applicants request reconsideration and withdrawal of these rejections.

First, as noted, Applicants cannot possibly respond to a rejection based on the premise that the Patent Office simply does not agree with Applicants position. In order to respond, Applicants need clarity of the nature and specifics of the rejection or, in this case, disagreement. In the absence of such, Applicants would have to respond solely on conjecture of what they might suspect the basis for the rejections or disagreements to be. Obviously, this is neither possible nor appropriate.

Secondly, the Patent Office's comment that the phrase "can have" does not mean that it must have the particular property recited is itself in error. The Patent Office's implication that "can have" suggests that parameter need not exist or that it is optional is directly contrary to the well understood meaning of the word "can": "to be able to". Here, one must be able to inscribe circles of the specified diameter in the surface area of the adhesive. No other connotation is possible, particularly in light of the specification.

Third, in order to address the Patent Office's concern with respect to the uncertainty of the lower limit of the diameter of the inscribed circles, Applicants have amended all of the pertinent claims to include the lower limit of 0.001" as recited in the specification. Applicants are not making this amendment to overcome art, nor is there any intent or expectation that the inclusion of this limitation would create any estoppel. It is merely being added to facilitate and expedite

allowance of this application. Indeed, since the claim requires that at least 35% of the surface area of the adhesive be able to have inscribed within it circles of a certain maximum diameter, the adhesive must be present and must have a surface area which, by definition and logic, requires a diameter greater than zero.

In view of the foregoing discussion, it is clear that Applicants have understood the rationale of the rejections, but that the Patent Office has not understood the rationale of the response nor the clear meaning of the claims. Applicants respectfully request that the claims, as amended, be examined in light of the further clarification provided by this response.

Though, as noted above, it is unclear what the basis for the Patent Office's continued rejections of the present invention are in view of the cited art, from the foregoing discussion, especially the arguments made in Applicants' prior response which is hereby incorporated by reference, it is clear that none of the art relied upon by the Patent Office contemplates, suggests, discloses or makes obvious the attributes and requirements of Applicants' invention as originally claimed. As Applicants believe their invention as claimed is patentable over the art and is in proper form for allowance, Applicants respectfully request that the application be given favorable reconsideration and passed on to allowance.

#### Withdrawal of Final Rejection as Premature

Should allowance not be forthcoming, Applicants respectfully request that the finality of the February 19, 2003 Office Action be withdrawn as premature. It is clear from the foregoing discussion that the reiteration of the rejection under 35 USC 112 with respect to the duplication of claims was unfounded and that the additional rejection under 35 USC 112, i.e., in relation to the extraneous phrases, is a new ground of rejection that is neither necessitated by Applicants' amendments (as there were none) nor any new art submitted with and IDS (MPEP 706.07(a)). Thus, a Final Rejection in this respect is premature.

Similarly, the finality of the Office Action in view of the Patent Office's art based rejections is premature. MPEP 706.07 states, in part, that in making a final rejection, all grounds of rejection of record "...must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal...However, where a single previous Office Action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply." In Paragraph 3 of the current Office Action the Patent Office states that the claims are rejected "...substantially for the reasons set forth in paragraph No. 7 of Paper no. 10, together with the following additional observations." The Patent Office then goes on to state that "Applicants' remarks (Response, page 2 – page 3) that the relied upon rejections are improper is simply not agreed with for the reasons of record."

To state that the rejections are "substantially" for the reasons set forth previously suggests that they are not identical; yet there is no discussion as to how they are different. Additionally, as noted above, to merely state that the Patent Office simply disagrees with the arguments presented by Applicants, particularly without an identification or comment as to the specific points of contention, provides no record or basis from which an appeal can be taken. To state that

Applicants' arguments are not agreed with "for the reasons of record" is meaningless as it implies that at some point during the prosecution, the Patent Office actually commented upon Applicants' arguments. However, the only Office Action issued since Applicants' made their arguments is the Final Rejection itself, which makes no effort to address and rebut Applicants' arguments. Furthermore, the Patent Office has entered new grounds of rejection in relation to Applicants' use of the language "can have" and the phrase "or less" in relation to the dimensions of the inscribed circles, which new grounds of rejection are neither necessitated by Applicants' amendments (as there were none) nor any new art submitted with an IDS (MPEP 706.07(a)). Thus, again, a Final Rejection in this respect is premature.

#### Fees

Inasmuch as there have been no changes to the number of claims by this amendment and this amendment is being timely filed, there are no fees associated with this submission.

#### Associate Power of Attorney

Should the Examiner continue to have concerns relative to clarity of the claims or the invention itself, the undersigned would be happy to address those issues by telephone. An Associate Power of Attorney from the Attorney of Record is enclosed making the undersigned an Attorney of Record.

Respectfully submitted,



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#### Certificate of Mailing

I hereby certify that this document and any attachments referenced herein are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Assistant Commissioner for Patent, Box AF, Washington, DC 20231 on this date.

  
Edward K. Welch II

Date: 3/14/03

## APPENDIX 1

Claims marked to show the amendments.

Claims 1, 2, 6, 7, 15, 39, 40, 41, 60, 61, 65 and 66 have been amended as follows:

1. (amended) A fastening device for promoting the assembly and adherence of associated pieces upon exposure to electromagnetic energy, comprising a susceptor sheet and a heat-activatable [heat-activateable] adhesive on at least one surface of said susceptor, wherein (a) when a test surface congruent in shape to the susceptor surface is placed onto the outward side of the adhesive, at least about 35% of the area of adhesive in contact with said test surface can have inscribed within it circles having a diameter of from about 1/2" to about 0.001" [or less].
2. (amended) The fastening device according to Claim 1 wherein at least about 35% of the area in contact with said test surface can have inscribed within it circles having a diameter of about 1/4" to about 0.001" [or less].
6. (amended) The fastening device according to Claim 5 wherein (c) when a test surface congruent in shape to the susceptor surface is placed against the inward side of the adhesive, at least about 35% of the area of the inward side of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of from about 1/2" to about 0.001" [or less].
7. (amended) The fastening device according to Claim 6 wherein at least about 35% of the area of the inward side of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of about 1/4" to about 0.001" [or less].
15. (amended) The fastening device according to Claim 10 wherein
  - at least about 50% of the area of the outward surface of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of about 1/4" to about 0.001" [or less];
  - from about 0.001% of to about 15% of the area of the test surface is in pre-bonding contact with the outward surface of the adhesive; and
  - from about 1% to about 35% of the total area of the test surface is in contact with the adhesive, as measured by the post-bonding test procedure defined herein.
39. (amended) The fastening device according to Claim 22 wherein[:]
  - at least about 50% of the area of the outward surface of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of about 1/4" to about 0.001" [or less];[and]
  - from about 0.001% of to about 15% of the area of the test surface is in pre-bonding contact with the outward surface of the adhesive; and
  - from about 1% to about 35% of the total area of the test surface is in contact with the adhesive, as measured by the post-bonding test procedure defined herein.
40. (amended) The fastening device according to Claim 39 wherein at least about 50% of the area of the outward surface of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of about 3/16" to about 0.001" [or less].

41. (amended) The fastening device according to Claim 39 wherein at least about 75% of the area of the outward surface of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of about  $\frac{3}{16}$ " to about 0.001" [or less].

60. (amended) A fastening device for promoting the assembly and adherence of associated pieces upon exposure to electromagnetic energy, comprising a susceptor sheet and a heat-activatable [heat-activateable] adhesive on at least one surface of said susceptor, wherein (c) when a test surface congruent in shape to the susceptor surface is placed against the inward side of the adhesive, at least about 35% of the area of the inward side of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of  $\frac{1}{2}$ " to 0.001" [or less].

61. (amended) The fastening device according to Claim 60 wherein at least about 35% of the area of the inward side of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of  $\frac{1}{4}$ " to 0.001" [or less].

65. (amended) The fastening device according to Claim 63 wherein (a) when a test surface congruent in shape to the susceptor surface is placed on the outward side of the adhesive, at least about 35% of the area of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of  $\frac{1}{2}$ " to 0.001" [or less].

66. (amended) The fastening device according to Claim 65 wherein at least about 35% of the area of the adhesive in contact with said test surface can have inscribed within it circles having a diameter of  $\frac{1}{4}$ " to 0.001" [or less].